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10/613,317	07/07/2003	Craig K. Chandler		4837

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EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/613,317

Applicant(s)

CHANDLER, CRAIG K.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on papers filed 6/28/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/7/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

K. L. Bell

**Detailed Action**

**Claim Rejection – 35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or foreign country, before the invention thereof by the applicant for patent.

Claim 1 is rejected under 35 U.S.C. 102(a) based upon the instant invention (cultivar) being known and used in this country.

The journal article by Rondon et al. (Strawberry cultivars grown under protected structure and their susceptibility to natural infestation of the cotton aphid, *Aphis gossypii* glover; Abstract only) describes 'Carmine' as being known to others; Silvia Rondon, Ashwin Paranjpe, and Daniel Cantliffe, whom are different than the instant inventor. The journal article also describes 'Carmine' being used in evaluating the susceptibility of different strawberry plants following the exposure to the cotton aphid while grown in a greenhouse.

The 102(a) rejection can be overcome by applicant filing a "Katz" type declaration explaining that the persons set forth above were known by the inventor and why the instant invention was not known in this country prior to the filing of the instant application. The declaration can also explain why the instant invention was not in public use, possibly explaining

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that the persons, Silvia Rondon, Ashwin Paranjpe, and Daniel Cantliffe, had a testing agreement with the instant inventor and that the instant plant was not sold more than one year prior to the filing of the instant application.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 3, Applicant should set forth in the specification the cultivar designation such as --Cultivar designation: 'Carmine'--.

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B. Page 2, line 6, Applicant states "from all other strawberry plants". Rather than stating the recitation above it is suggested that Applicant insert --from all other strawberry plants known to the inventor-- as it is in the realm of possibility that another strawberry variety with the same or similar characteristics exists unknown to the inventor.

C. Page 2, lines 10 and 11, Applicant should set forth in the specification a brief description for each photographic drawing in the application.

D. Page 2, line 15, Applicant states "[www.pantone.com](http://www.pantone.com)". The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

E. Applicant should set forth in the specification additional information relative to the instant plant's leaflets including the typical and observed leaflet shape and apex and base descriptors.

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F. Applicant should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal shape and apex, margin, and base descriptors.

G. Applicant should set forth in the specification additional information relative to the instant plant's corolla including the typical and observed corolla depth.

H. Applicant should set forth in the specification information relative to the instant plant's sepals including the typical and observed sepal number, shape, length, width, and apex and margin descriptors.

I. Applicant should set forth in the specification additional information relative to the instant plant's pedicles including the typical and observed pedicel diameter and coloration with reference to the employed color chart.

J. Page 3, line 22, Applicant states "[www.nass.usda.gov/fl.com](http://www.nass.usda.gov/fl.com)". The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

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K. Page 5, Table 1, page 6, Table 2, page 7, Table 3, and page 8, Table 4, Applicant sets forth letters, "a", "b", "c", "ab", "abc", and "bc", but do not set forth what the letters represent. Applicant should set forth in the specification what the letters represent. Correction and/or clarification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.



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**Detailed Action**

**Potential 102**

Applicant is required to provide the necessary information set forth in the attached Requirement for Information under 37 CFR 1.105 as it appears the plant may have been sold at least one year prior to the filing of the instant application.

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*

KAB  
7/25/05  
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## Detailed Action

### REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The information is required to determine the accessibility of the foreign sales and the reproducibility of the plants that were sold to the public, more than one year prior to the effective filing date of this application.

The information is required to determine when, and to what extent, the claimed plant variety 'Carmine', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide (to the extent not already provided):

- a) a copy of any plant breeder's rights applications, published proposed denominations, and breeder's rights grants, relating to the claimed plant variety;
- b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed variety anywhere in the world if the sale, offer for sale, or public distribution occurred at least one year prior to the filing date of this application;
- c) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world which occurred at least one year prior to the filing date of this application, including the date(s) and location(s)

The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or the assignee can

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readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 3 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).